REMARKS

Applicants request reconsideration of the application in view of the present Amendment.

35 U.S.C. § 102(e)

Applicant respectfully maintains that Senkan (U.S. Pat. No. 6,426,226) is not prior art under 35 U.S.C. § 102(e). Examination Guidelines, Significant Provisions paragraph F, as cited in Applicants' Amendment filed September 18, 2003, provides the following:

> **F. When an international application cannot serve as a bridge to an earlier-filed application.**
>
> International applications, which: (1) were filed prior to November 29, 2000, . . . **may not be used** to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. § 102(e).

For further explanation, the Examiner is referred to example 9 of MPEP 706.02(f)(1) (Rev. 1, Feb. 2003), found on page 700-36, for an example that is consistent with the instant situation. Example 9 provides that a continuation of an International Application (IA) that was filed prior to November 29, 2000, "ha[s] the 35 U.S.C. 102(e) prior art date of [its] actual U.S. filing date under 35 U.S.C. 102(e). No benefit of the international filing date (**nor any U.S. filing date prior to the IA**) is given for 35 U.S.C. 102(e) prior art purposes since the IA was filed prior to November 29, 2000." Senkan is a continuation of an IA that was filed prior to November 29, 2000. Thus, Senkan is not prior art under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a)

Each of claims 39-76 requires the use of a second sensor to measure a second parameter of one or more building blocks. Willson does not teach or suggest more than one sensor in the analysis of a library. Fawcett, who uses three analytical techniques to evaluate a single sample, provides no teaching or suggestion regarding the analysis of more than one sample. Applicants respectfully submit that there is no motivation or suggestion to combine the teachings of Willson and Fawcett in a manner that derives the claimed invention out of the prior art. This is because the analyses of Willson and Fawcett are incompatible with each other, and there would be no expectation of success for a combination of their teachings.

Several critical differences exist between the instrument of Willson and the instrument of Fawcett, and these differences would prevent one of skill in the art from finding any motivation to combine the two references. First, the instrument of Willson is configured to analyze catalytic **reaction products** that exist in the gas phase. On the other hand, the instrument of Fawcett is configured to characterize the **intrinsic physical properties** of a solid phase material. Willson and Fawcett, thus, relate to analyses that are entirely different from each other with no overlapping aspects of a sample, and neither provides any motivation toward a combination. Instead, one of ordinary skill in the art who is interested in analyzing gas phase catalytic reaction products would dismiss Fawcett as irrelevant because Fawcett's instrument is configured to characterize intrinsic physical properties and he would have no expectation of success.

Second, aside from mass spectrometry, the sensors of Willson do not overlap with the sensors of Fawcett. This is for good reasons. Differential scanning calorimetry (DSC) involves the ultra sensitive monitoring of the weight of a sample. Because the weight of a sample is monitored, the sample must be individually isolated on a scale. If a library of materials were placed on a DSC scale, the weight changes of every sample would be represented in one weight measurement, and information on individual samples would not be retrievable. Even if one sample were isolated on a library for an individual DSC analysis, in order to perform the analysis that sample must be run through a heat cycle. Because the sample is part of a library, each sample in the whole library would be heated and would then go through chemical changes that may not be reversible. If one of the non-analyzed samples on a library undergoes non-reversible changes, that sample will be altered and will never be analyzable with respect to its initial physical parameters. Analysis of a library by DSC would thus be inoperative and, therefore, could not be obvious under 35 U.S.C. § 103(a) because a modification that renders a prior art disclosure inoperative can not be considered obvious under 35 U.S.C. § 103(a).

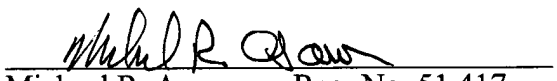
Fawcett's x-ray diffraction also is incompatible with Willson's analysis of a library of materials. X-ray diffraction requires the ability to reproducibly direct x-rays through a sample and to monitor the diffraction pattern generated by that sample. In Fawcett, as the crystalline structure of a sample changes during heating, changes in diffraction pattern are monitored. As discussed above, because only one sample of a library can be monitored at a time, samples not under analysis could undergo non-reversible changes that render them unanalyzable. Further, the

x-rays of Fawcett appear to pass horizontally through a sample on the DSC scale. Expanding this setup to a 2-dimensional library would make the device inoperative because the x-rays would have to pass through more than one sample, and the resulting diffraction pattern would not be of a single sample. Analysis of a library by x-ray diffraction would thus be inoperative and, therefore, could not be obvious under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that claims 39-76 could not have been made obvious by Willson and Fawcett under 35 U.S.C. § 103(a), and the application is in condition for allowance, and allowance is respectfully requested.

Respectfully submitted,



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